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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,396	09/27/2001	Henry H. Smith	3691-311	1122
23117	7590	05/04/2005	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			LEE, EDMUND H	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,396

Applicant(s)

SMITH ET AL.

Examiner

EDMUND H. LEE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29 and 33-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 29,33-36 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 29 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6319438 (hereinafter USPN '438). Although the conflicting claims are not identical, they are not patentably distinct from each other because USPN '438 teaches the basic claimed process including extruding a colored layer including metallizing material. It is well-known in the molding art and automotive art not to use a metallizing material in a colored layer in order to create a non-metal appearance. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to not include metallizing material in the colored layer of USPN '438 in order to form a trim having a non-metallic appearance.

3. Claim 33 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6319438 (hereinafter USPN '438). Although the conflicting claims are not identical, they are not

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patentably distinct from each other because USPN '438 teaches extruding an approximately planar sheet; extruding a colored layer including metallizing material; and providing a clear coat of thermoplastic fluorinated polymer. USPN '438 does not teach a tie layer including color pigment material therein. In regard to extruding an approximately planar sheet, it is well-known in the molding art not to extrude an approximately planar sheet. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to not extrude an approximately planar sheet in order to reduce stress upon the layer during 3D vacuum forming. In regard to extruding a colored layer including metallizing material, it is well-known in the molding art and automotive art not to use a metallizing material in a colored layer in order to create a non-metal appearance. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to not include metallizing material in the colored layer of USPN '438 in order to form a trim having a non-metallic appearance. In regard to providing a clear coat of thermoplastic fluorinated polymer, it is well-known in the molding art and automotive art to use clear coats of other than thermoplastic fluorinated polymer. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a clear coats of other than thermoplastic fluorinated polymer in order to reduce material costs. In regard to a tie layer including color pigment material therein, such is well-known in the molding art in order to enhance the aesthetic appeal of a molded trim. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a tie

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layer with color pigment therein in order to enhance the aesthetic appeal of the molded trim.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roys et al (USPN 6284183) in view of Johnson et al (USPN 5518786). In regard to claim 33, Roys et al teach the basic claimed process including a method of making a colored automotive trim product (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8); extruding a colored layer including color pigment, the colored layer being the layer that primarily determines the color of the trim product when viewed from the vehicle exterior (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8); providing a substantially transparent clear coat layer over the colored layer (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8); positioning the substantially transparent clear coat layer together with the colored layer in a vacuum forming apparatus (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8); vacuum forming the clear coat layer together with the colored layer into a three dimensionally shaped preform (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8); and utilizing the three

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dimensionally shaped preform as at least a portion of an exterior trim product for a vehicle (abstract; col 4, Ins 22-26,45-46 and 53-55; col 5, Ins 47-50; col 6, Ins 1-3; col 9, Ins 1-2; figs 1-8). Roys et al, however, do not teach providing at least one tie layer between the colored layer and the substantially transparent clear coat layer, wherein the tie layer includes color pigment material therein as is for promoting adhesion between the colored layer and the clear coat layer. Johnson et al teaches molding an exterior automotive laminate wherein the laminate includes a tie layer between a color layer and a clear coat (figs 1-5). Roys et al and Johnson et al are combinable because they are analogous with respect to molding exterior automotive laminates. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a tie layer as taught by Johnson et al between the colored layer and clear coat layer of Roys et al in order to enhance the bonding between the layers. In regard to claims 34-36, such is taught by Roys et al (abstract; col 4, Ins 22-26,45-46 and 53-55; col 5, Ins 47-50; col 6, Ins 1-3; col 9, Ins 1-2; figs 1-8).

6. Applicant's arguments with respect to claims 33-36 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within


TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE
Primary Examiner
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5/2/05